

**REMARKS**

[0001] The following paragraphs are numbered for ease of future prosecution. Claims 16-17 and 30-31 are all the claims presently pending in this application. Claims 16 and 30 have been amended to more particularly define the claimed invention.

[0002] Applicant respectfully submits that entry of the currently amended claims is proper because the currently amended claims will either place the application in condition for allowance or in better form for appeal. Applicant further respectfully submits that no new matter is added to the currently amended claims, nor has the scope of the pending claims changed. Applicant respectfully traverses the rejections based on the following discussion.

**I. REJECTION UNDER 35 U.S.C. §101**

[0003] Claims 16 and 30-31 have been rejected under 35 U.S.C. §101 as being directed toward non-statutory subject matter as not (1) being tied to a particular machine or apparatus, or (2) transforming a particular article to a different state or thing. Applicant has amended claim 16 to recite, “An automated computer implemented method...,” with corresponding clauses each performed, “by said computer,” thus satisfying the “tied to a particular machine” requirement. Furthermore, claim 30 recites “outputting said applicable provisions of said codes by said computer,” fulfilling the transforming a particular article “code” to a different state or thing, “applicable provisions of said codes,” and that, “by said computer.”

[0004] Additionally, Applicant has amended claim 30 to recite, “A program storage medium readable by a machine, tangibly embodying a program of instructions executable by said machine to perform an automated method for interpreting codes,” thereby fulfilling the In re Lowery

requirement. “When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency). M.P.E.P. § 2106.01 Computer-Related Nonstatutory Subject Matter

[0005] Applicant’s amendment also satisfies the two corollaries of the “**machine-or-transformation**” test of *In re Bilsky*, since the amendment: 1) is not merely field-of-use limitation by imposing meaningful limits on the method claim's scope; and 2) does not merely add insignificant extra-solution activity by reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008).

[0006] Additionally, the Examiner on the bottom of page 4 of the Non-Final Office Action rejections the pending claims 16-17 and 30-31 under 35 U.S.C. §101 as being “preemptive and very [sic] abstract idea.” Applicant has amended the preamble of both independent claims 16 and 30 to recite, “identifying applicable provisions in codes,” in place of “*interpreting...*”

[0007] Applicant respectfully requests that the Examiner withdraw these 35 U.S.C. §101 rejections.

## II. OBJECTION TO THE CLAIMS

[0008] Claims 16-17 and 30 are objected to because none of the claims are directed to statutory subject matter. Applicant has amended the claims in a manner believed fully responsive to all

points raised by the Examiner. Applicant's independent claim 16 has been amended to recite, e.g., "*selecting a rules system by a computer...*" "*mapping said codes to target rules...by said computer*," etc. Additionally, claims 16 and 30 have been amended to replace, "*if-the-else-rules*," with "*if-then-else-rules*." Applicant respectfully requests that the Examiner withdraw this claim objection.

### III. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

[0009] Claims 16 and 30 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for reciting the limitation "*said rule system*" without allegedly having any antecedent basis for this limitation. Applicant's claim language states, "*a rule system*," from which "*said rule system*" derives its antecedent basis. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection. Applicant respectfully requests that the Examiner withdraw this 35 U.S.C. §112 rejection.

### IV. THE PRIOR ART REJECTION

#### **The 35 U.S.C. § 103(a) Rejection over Zambo further in view of McCollum, Bigus and AAPA**

[0010] Claims 16-17 and 30-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zambo et al., U.S. Pat. No. 6,985,907, (hereinafter "Zambo"), further in view of McCollum et al., U.S. Pat. App. Pub. No. 2005/0091640, Bigus et al., U.S. Pat. No. 7,136,843 and further in view of Applicant's Admitted Prior Art, (hereinafter "McCollum," "Bigus" and "AAPA," respectively).

[0011] The Examiner alleges that one of ordinary skill in the art would have been motivated to

modify Zambo with the teaching from McCollum, Bigus and AAPA to form the invention of claims 16-17 and 30-31. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0012] Applicant traverses the Examiner's rejection since, among other reasons, Zambo discloses a computer-implemented method for attributing applicable condition codes to a field claim by inputting a text comment associated with the field claim, that is, inputting a plurality of condition codes and at least four keyword combinations of at least two non-sequential keywords for each condition code, and for each condition code, attributing the condition code as an applicable condition code if at least one keyword combination for the condition code is included in the text comment. Whereas, Applicant's claimed invention is directed toward selecting a rules system such that codes are represented in a form corresponding to a particular type of analysis to be performed on said codes, then mapping said codes to target rules representing said codes based on said selected rules by either transforming a logical structure of said codes to target rules using grammar and syntax of said selected rules system, or populating a template of generated target rules with data from said codes based on said selected rules system. A first evaluation function comprising one user's perspective of said codes, and a second evaluation function comprising a triggering event relating to said codes is applied to the target rules to identify and output applicable provisions of the codes.

[0013] More specifically, Applicant submits, that neither Zambo, nor McCollum, Bigus and AAPA, nor any alleged combination thereof, teaches or suggests:

*“selecting a rules system by a computer such that codes are represented in a form corresponding to a particular type of analysis to be performed on said codes, wherein said rules*

*system including one of fuzzy rules, if-then-else-rules and declarative rules, and wherein said codes comprise natural language text of one of laws, policy statement, contract provisions, agreements, regulations, rules of association, constitutions, and codes of conduct,”*

*“mapping said codes to target rules representing said codes based on said selected rules system by said computer, by one of: transforming a logical structure of said codes to target rules using grammar and syntax of said selected rules system; and populating a template of generated target rules with data from said codes based on said selected rules system,”*

*“applying evaluation functions to said target rules by said computer, to identify applicable provisions of said codes, wherein a first evaluation function comprises one user's perspective of said codes, and wherein a second evaluation function comprises a triggering event relating to said codes,”*

*“identifying applicable provisions of said codes based on said first and second evaluations by said computer, wherein said applicable provisions of said codes match said first and second evaluation functions as applied to said target rules,” and*

*“outputting said applicable provisions of said codes by said computer,”* of Applicant’s independent claim 16, and similarly, independent claim 30.

[0014] The Examiner alleges “Zambo teaches an automated method for interpreting codes (col. 2, lines 19-21).” Zambo discloses codifying field claims with the most severe applicable condition codes where a field claim can be codified with the most severe of the applicable condition codes based on a severity ranking of the plurality of condition codes. Zambo discloses field claims consisting of merely of warranty claims and field concerns (column 1, lines 14-18). Zambo’s condition codes “CCs” are identified in Table 1 as being “tire condition” codes ranked in order of severity. Zambo fails to teach or suggest, “identifying applicable provisions in

codes,” per Applicant’s claimed invention, since there is no disclosure related to “applicable provisions,” in the conditions codes “CC” (TA1...TC6), other than tire description condition itself which is not a “code” per the disclosure of Zambo, but merely a description of the condition code.

[0015] The Examiner alleges “Zambo teaches the claimed, target rule technology is selected of a representation of said codes using a rule system (Table 2, col. 6, lines 65-67).” Table 2, to which the Examiner cites in Zambo are merely “simple keywords” used as search criteria for searching user inputted text comments in an associated field claim to apply a particular condition code “CC”. Nowhere in Zambo is there any teaching or suggestion of a “rules system...such that codes are represented in a form corresponding to a particular type of analysis to be performed on said codes.”

[0016] Furthermore, Zambo fails to teach or suggest the condition codes “CC” consist of Applicant’s claimed, “comprise natural language text of one of laws, policy statement, contract provisions, agreements, regulations, rules of association, constitutions, and codes of conduct.” Condition codes are merely alphanumeric characters associated with particular conditions, e.g., in Table 1, tire conditions.

[0017] The Examiner alleges “Zambo teaches the claimed, mapping said codes to target rules (Fig. 2, col. 4, lines 45-61).” Zambo merely teaches ranking the condition codes “CCs” based on a severity of a condition; i.e., major categories A-C, and subcategories 1+. No “target rules” are disclosed by Zambo and neither does the Examiner comment on where Applicant’s “target rules” are taught by Zambo. Furthermore, the description “Tire Condition” cannot be equated to Applicant’s claimed “target rules” since these are merely descriptions and have no function as a “rule.”

[0018] Furthermore, Zambo fails to teach or suggest mapping said codes to target rules by “transforming a logical structure of said codes to target rules using grammar and syntax of said selected rules system,” and “populating a template of generated target rules with data from said codes based on said selected rules system.”

[0019] The Examiner alleges “Zambo teaches the claimed, providing for said one user's use text of said applicable codes (Fig. 1. Table 1, col. 6, line 56 to col.7 line 14).” Column 6, lines 56-64 merely disclose a “field claim” incorporating a “technician text comment.” Nowhere does Zambo disclose and nowhere does the Examiner how this “technician text comment” comprises a first evaluation function applied to target rules, (which Zambo fails to teach or suggest, per Applicant's above argument). Neither does Zambo teach or suggest Applicant's claimed “a second evaluation function comprises a triggering event relating to said codes.”

[0020] The Examiner admits that, “Zambo does not explicitly teach rules,” and alleges that “McCollum teaches the claimed, applying evaluation functions to said target rules that represent said codes, to identify applicable provisions of said codes (Fig. 1, page 2, paragraph [0005]).” McCollum discloses “rules definition language (RDL) that includes statements that facilitate efficient use of computer resources by allowing a rule to be broken down into one or more instructions, and processing these instructions asynchronously to provide more efficient use of the computer resources.” However, nowhere does the Examiner identify how these “rules” of McCollum are related to any disclosure of Zambo's condition codes “CCs”, in fact, the Examiner fails to provide any motivation for combining the disclosure of McCollum with Zambo.

Applicant respectfully submits that Zambo would not have been combined with McCollum as alleged by the Examiner since these references are non-analogous because they are completely unrelated. McCollum is directed towards allowing a rule to be broken down into one or more

instructions which is completely unrelated to the disclosure of Zambo directed toward codifying field claims with the most severe applicable condition codes where a field claim can be codified with the most severe of the applicable condition codes based on a severity ranking of the plurality of condition codes. No person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner.

[0021] Furthermore, nowhere in McCollum is there any disclosure, and the Examiner fails to identify what elements of McCollum teach or suggest Applicant's claimed, "applying evaluation functions to said target rules by said computer, to identify applicable provisions of said codes."

Paragraph [0005] to which the Examiner alleges discloses the above portion of Applicant's claimed invention merely discloses, "allowing a rule to be broken down into one or more instructions." It appears that the "rule to be broken down" of McCollum is completely disembodied from any application to the disclosure of Zambo. Applicant again maintains that the Examiner's rejection is based on hindsight reasoning.

[0022] Furthermore, nowhere in McCollum is there any disclosure, and the Examiner fails to identify what elements of McCollum teach or suggest Applicant's claimed, "wherein a first evaluation function comprises one user's perspective of said codes, and wherein a second evaluation function comprises a triggering event relating to said codes." Paragraph [0003] to which the Examiner alleges discloses the above portion of Applicant's claimed invention merely discloses, "a rule may watch the state of a system disk and report an error when the disk usage goes below a certain threshold. Another rule may monitor the CPU utilization and report an error when the utilization crosses a certain threshold. In a typical monitoring system, both rules would



run simultaneously.” Nowhere does the Examiner explain how the “watch rule” and the “monitor rule” of McCollum relate to any provision of Zambo, much less any “*target rules*” to which Zambo is silent and McCollum is completely unrelated.

[0023] The Examiner admits that, “Zambo does not explicitly teach applying evaluation function to said rules,” and alleges that “McCollum also teaches the claimed, applying evaluation functions to said target rules that represent said codes, to identify applicable provisions of said codes, wherein a first evaluation function comprises one user's perspective of said codes, and wherein a second evaluation function comprises a trigger event relating to said codes (Fig. 3, page 14, paragraph [0236]).” Paragraph [0236] discloses:

[0024] [a] model-based system can employ classifiers that are explicitly trained (e.g., via a generic training data) as well as implicitly trained (e.g., via observing user behavior, receiving extrinsic information) so that the classifier(s) is used to automatically determine according to a predetermined criteria, for example, what initial settings to use for a given implementation, and then adjusting the settings over time as the system matures and experiences various loading conditions with respect to data, number of installed applications, and the number of nodes with which to interact.... Classifiers can also be employed to capture and analyze transaction logs, look for patterns, and diagnose a system by looking for successful and unsuccessful patterns.

However, nowhere in paragraph [0236] is there any disclosure and nowhere does the Examiner identify where any element of McCollum from this recitation is equivalent to Applicant's claimed, “*applying evaluation functions to said target rules...*”

[0025] Moreover, the Examiner's alleged statement of motivation, “because McCollum's teachings would have allowed Zambo's method to execute plurality of rules simultaneously instead of executing sequentially in order to use computer resources more efficiently,” is completely erroneous since Zambo, by the Examiner's own admission, fails to disclose “rules” and that both references, as argued above, are completely non-analogous and unrelated.

[0026] The Examiner admits that, “Zambo, McCollum and does not explicitly teach rule system,” and alleges that “Bigus teaches the claimed, a rule system, said rule system including one of fuzzy rules, if-the else-rules, and declarative rules (col. 4, line 64 to col. 5, line 2; col. 4, lines 30-33 and col. 5, lines 15-26).” However, nowhere does the Examiner identify how the “different types of rules” of Bigus are related to any disclosure of Zambo’s condition codes “CCs”, in fact, the Examiner fails to provide any legitimate motivation for combining the disclosure of Bigus with Zambo and McCollum. Applicant respectfully submits that Zambo and McCollum would not have been combined with Bigus as alleged by the Examiner since Bigus is non-analogous because it is completely unrelated. Bigus is directed toward computer program product for implementing a rule-based programming language. No person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight, especially since by the Examiner’s own admission that the primary reference to Zambo fails to teach “target rules,” whatsoever. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner.

[0027] In fact, the erroneous motivation provided by the Examiner, “McCollum's teachings would have allowed Zambo's method for initialization or setup code is required to intermix with the processing and evaluation of declarative rules-based knowledge (col. 1, lines 64-67),” fails to even identify any element of Bigus allegedly used in combination with either McCollum or Zambo.

[0028] The Examiner admits that, “Zambo and McCollum and does not explicitly teach types of codes,” but alleges that “AAPA teaches the claimed, codes comprise any of laws, policy statements, contract provisions, agreements, regulations, rules of association, constitutions, and

codes of conduct (page 1, paragraph [0002]).” Applicant respectfully traverses the application of Applicant’s Specification at paragraph [0002] as being equivalent to “Applicant’s Admitted Prior Art.” Paragraph [0002] merely discloses the definition of the term “code” in the context of Applicant’s disclosure of the instant invention, that is:

The term code, and codified provisions, is used herein to refer to any set of formalized statements of conduct of individuals or legal entities, such as corporations. Such codes may be laws, such as those of civil or criminal justice, international laws, policy statements, contract provisions, agreements, regulations, rules of association, constitutions, codes of conduct, and so on.

[0029] Moreover, nowhere is there any cited prior art of record that “*identifies applicable provisions in codes...comprising natural language text of one of laws, policy statement, contract provisions, agreements, regulations, rules of association, constitutions, and codes of conduct.*”

[0030] In summary, Zambo discloses a computer-implemented method for attributing applicable condition codes to a field claim by inputting a text comment associated with the field claim, that is, inputting a plurality of condition codes and at least four keyword combinations of at least two non-sequential keywords for each condition code, and for each condition code, attributing the condition code as an applicable condition code if at least one keyword combination for the condition code is included in the text comment. Applicant’s claimed invention is directed toward selecting a rules system such that codes are represented in a form corresponding to a particular type of analysis to be performed on said codes, then mapping said codes to target rules representing said codes based on said selected rules by either transforming a logical structure of said codes to target rules using grammar and syntax of said selected rules system, or populating a template of generated target rules with data from said codes based on said selected rules system. A first evaluation function comprising one user’s perspective of said codes, and a second evaluation function comprising a triggering event relating to said codes is applied to the target

rules to identify and output applicable provisions of the codes.

[0031] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Zambo and McCollum, Bigus and AAPA (either alone or in combination) fail to teach or suggest each element and feature of Applicant's claimed invention.

## **V. FORMAL MATTERS AND CONCLUSION**

[0032] In view of the foregoing, Applicant submits that claims 16-17 and 30-31, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

[0033] Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic interview.

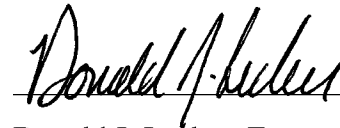
Application No. 10/729,813  
Docket No. JP920030179US1

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[0034] The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Date: February 19, 2009

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Donald J. Lecher", written over a horizontal line.

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